

# UNITED STATES PATENT AND TRADEMARK OFFICE



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APPLICATION NO		FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/074,194 02/12/2002		02/12/2002	Cristina M. Rondinone	6792.US.01	4364
23492	7590	05/05/2004		EXAMINER	
STEVEN F. WEINSTOCK				FREDMAN, JEFFREY NORMAN	
ABBOTT LABORATORIES 100 ABBOTT PARK ROAD				ART UNIT	PAPER NUMBER
DEPT. 377	/AP6A		1637		
ABBOTT PARK, IL 60064-6008				DATE MAILED: 05/05/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

1)⊠ Responsive to communication(s) filed on 11 March 2004.  2a ☐ This action is FINAL. 2b)⊠ This action is non-final.  3]☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4 ☑ Claim(s) 1-24 Is/are pending in the application.  4a) Of the above claim(s) 13-24 is/are withdrawn from consideration.  5 ☐ Claim(s)		Application No.	Applicant(s)					
Juffrey Fredman  Juffrey  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  THE MAILING DATE OF THIS COMMUNICATION.  He Mailla Ma		10/074,194	RONDINONE ET AL.					
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Art Unit: 1637

#### **DETAILED ACTION**

### Election/Restrictions

1. Applicant's election of Group I, claims 1-12 in the paper filed March 11, 2004, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

## Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 3. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn et al (US 2002/0051786 A1).

Kahn et al teaches a method of claims 1, 5 and 9, for identifying a test compound which inhibits protein tyrosine phosphatase 1B (PTP1B) expression in liver or fat of a non-human mammal (see claim 20 and page 3, paragraph 0050)(see page 10, lines 10-14 of the provisional), the method comprising the steps of:

(a) treating an insulin resistant non-human mammal with said test compound for a time and under conditions sufficient to allow for a change in the level of expression of

Art Unit: 1637

at least one of PTP1B mRNA or protein in the liver or fat of said mammal (see claim 20 and page 3, paragraph 0050)(see page 10, lines 10-14 of the provisional),

- (b) removing the fat or liver from said mammal (see claim 23 and page 3, paragraph 0054, which refers to analysis of fat and liver)(see page 1, line 16 of provisional, which teaches the effect of compounds that treat diabetes on liver);
- (c) detecting the levels of phosphotidylinositol-3-kinase p85 $\alpha$  and p50 $\alpha$  and/or p55 $\alpha$  isoforms in said liver or fat (see claim 20 and page 3, paragraph 0050, where all three of p85 $\alpha$  and p50 $\alpha$  and p55 $\alpha$  are mentioned)(see page 10, lines 10-14 of provisional which refers to p85 $\alpha$  expression with regard to drug screening); and
- (d) determining whether the test compound inhibits at least one of PTP1B mRNA or protein in said liver or fat based upon on the levels of p85 $\alpha$  and p50 $\alpha$  and/or p55 $\alpha$  detected in said liver or fat (see claim 20 and page 3, paragraph 0050, where all three of p85 $\alpha$  and p50 $\alpha$  and p55 $\alpha$  are mentioned)(see page 10, lines 10-14 of provisional).

With regard to claims 2, 6, 10, Kahn teaches screening in mice (see page 4, paragraph 0061)(see page 10, lines 10-14 of the provisional where mice are also used).

With regard to claims 3, 7, 11, Kahn teaches agents including peptides, small molecules and antibodies (see claim 25)(see page 2, lines 5-8 of the provisional).

With regard to claims 4, 8, 12, Kahn teaches antisense agents (see page 6, paragraph 0086)(see page 2, lines 26-30 of the provisional).

Because the Kahn reference is a Pregrant publication which relies upon the provisional application to have priority over the current claim, the second parentheses points out basis in the priority document.

Application/Control Number: 10/074,194

Art Unit: 1637

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Jeffrey Fredman Primary Examiner Art Unit 1637 Page 4